

REMARKS

Claims 1-17 are pending in the present application. Claims 4-8 and 12-16 were withdrawn. Reconsideration of the claims is respectfully requested.

I. Examiner Interview

Applicants thank Examiner Bonshock for courtesies extended Applicants' representative on December 5, 2008. During the interview, Applicants' representative reviewed screenshots provided by the Examiner of MS Word 2000 (hereinafter *MSword*), as well as reviewed screenshots provided by Applicants' representative of *MSword*. Applicants' representative showed that the mouse cursor, following a display of the *MSword* clipboard, could be moved in a down and left movement several inches from the clipboard, yet the clipboard persisted. The Examiner agreed that the mouse, when moved in that direction, was not adjacent, and yet the clipboard failed to be removed in the manner of claim 17. However, the Examiner suggested that he remembered running tests in 2004, depicted in part by Figures 6 and 7 of Final Office Action, dated November 25, 2008, such that moving the cursor, between Figure 6 and Figure 7, could cause the clipboard to be removed. Applicants' representative performed exhaustive tests on a copy of *MSword* in real-time in an attempt to produce outputs that would result in the clipboard disappearing.

Applicants' representative moved the cursor from a location within the clipboard, to 2) a position entirely on the submenu 'Items'; and 3) upwards off the 'Items'. Again, *MSWord* failed to remove the clipboard, and therefore is inconsistent with claim 17. At the Examiner's urging, Applicants' representative further tested operation of the *MSword* clipboard. This third experiment was 1) cursor positioned within the clipboard boundaries; 2) cursor moved up and within the 'Items' submenu (still no clipboard removal), and finally 3) cursor moved left through the boundary of the 'Items'. At the moment that the pointed part of the arrow-cursor moved left of 'Items' submenu, the clipboard disappeared. Many further efforts moved the cursor through the left boundary, causing the clipboard to disappear upon the pointed part of the arrow-cursor penetrating the left boundary of 'Items'. Movement vertically was shown to be insufficient to cause the clipboard visibility to change. No agreement was reached, however, since the

Examiner expressed a desire to try the same experiments on his copy of *MSword*.

II. 35 U.S.C. § 102 Anticipation

The Examiner has rejected claim 17 under 35 U.S.C. § 102 as being unpatentable over a public use of Microsoft Word” (hereinafter *MSword*). Applicants respectfully traverse.

Claim 17 is recited below:

A method of displaying a clipboard comprising:
receiving a paste command;
determining whether a plurality of objects are stored within the clipboard
in response to the paste command;
displaying the clipboard adjacent a display position indicator, if it is
determined a plurality of objects are within the clipboard; and
removing the clipboard from a display in response to movement of the
display position indicator not adjacent to the clipboard.

[T]he role of the Examiner as finder of fact, the Court of Appeals for the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). “[P]reponderance of the evidence is the standard that must be met by the PTO in making rejections” *In re Caveney*, 761 F.2d 671, 674, 226 USPQ 1, 3 (Fed. Cir. 1985). Once the U.S. Patent and Trademark Office (USPTO) establishes a *prima facie* case, the burden of production or going forward with the evidence shifts to the applicant. *Cf. In re Epstein*, 32 F.3d 1559, 1570-71, 31 USPQ2d 1817, 1824-25 (Fed. Cir. 1994). (third-party software products were “in public use or on sale” more than one year before filing date based on abstracts stating “first installed” dates).

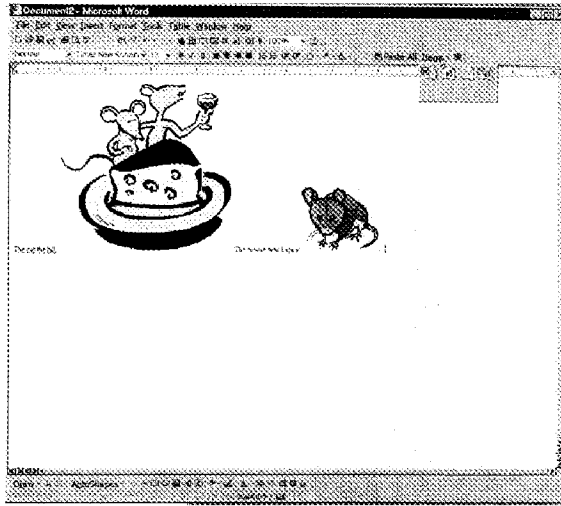


Figure 6

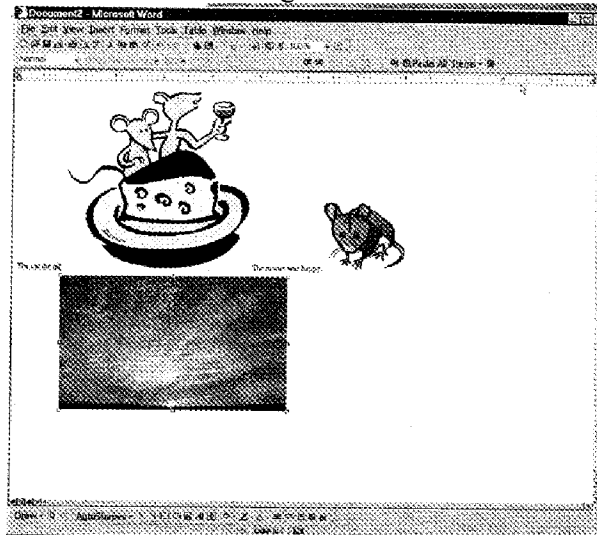


Figure 7

The Examiner offers Figure 6 as a snapshot depicting *MSword* before 'removing the clipboard from the display' as well as Figure 6 as allegedly teaching the claim 17 recited, "removing the clipboard".

With regard to claim 17, which further teaches removing the clipboard in response to moving the position indicator so that the position indicator is not adjacent to the clipboard, *MSword* teaches, in figures 6 and 7, hiding the clipboard upon position [sic] the indicator off of the clipboard and onto the document.

Final Office Action dated November 25, 2008, page 3.

In contrast, Applicants respectfully urge that the Figure 6 and Figure 7 show removal of a clipboard for reasons other than, as recited in claim 17, "in response to movement of the

display position indicator not adjacent to the clipboard”. In particular, Figure 7 shows the addition of a sunset image at the bottom of the *MSWord* document. Applicants urge that the appearance of the sunset image suggests that a mouse click intervened between the snapshot of Figure 6 and snapshot of Figure 7. Further, Applicants urge that the mouse click, and not the movement of the cursor above the clipboard, actually triggered a change in clipboard visibility. The appearance of the sunset image is inconsistent with the Examiner’s interpretation, as will be further explained below. Accordingly, the Examiner has not met his burden of proof to show that *MSWord* teaches the claimed feature, including causality, by a preponderance of the evidence. Moreover, the burden has not shifted to the Applicant, for the reason that the Examiner has not satisfied the preponderance of the evidence test.

Nevertheless, Applicants offer evidence of *MSWord* operation by way of the Affidavit, signed by Mr. Anthony Champion, of January 14, 2009, hereinafter *Champion Affidavit*.

The alternate and correct interpretation of the events before Figures 6 and/or 7 are supported by the attached Affidavit, wherein Mr. Champion attests to steps performed to make the *MSword* clipboard disappear. The photos of executing *MSword*, within the *Champion Affidavit*, were taken prior to Mr. Champion testing *MSWord*. The photos were taken of the Digital Hinote VP laptop on or about January 9, 2009. Mr. Champion validated such photos by testing a script of inputs on January 14, 2009 using the same Digital Hinote VP laptop. Applicants are willing to stipulate that a Digital Hinote VP laptop running the Microsoft Windows 98 operating system coupled with the Microsoft Word 2000 software was in public use on or before the present application was filed.

The *MSword* responds to events, which are in turn driven by the geometry of the graphic elements. *MSWord* responses are controlled by computer instructions. Inferences can be gained as to the operation of *MSword* by experimenting with the actual software operating on a computer using an operating system that was also publicly available prior to the Applicants application filing.

For convenience, certain features of the menu and/or clipboard are illustrated with numeric callouts below.

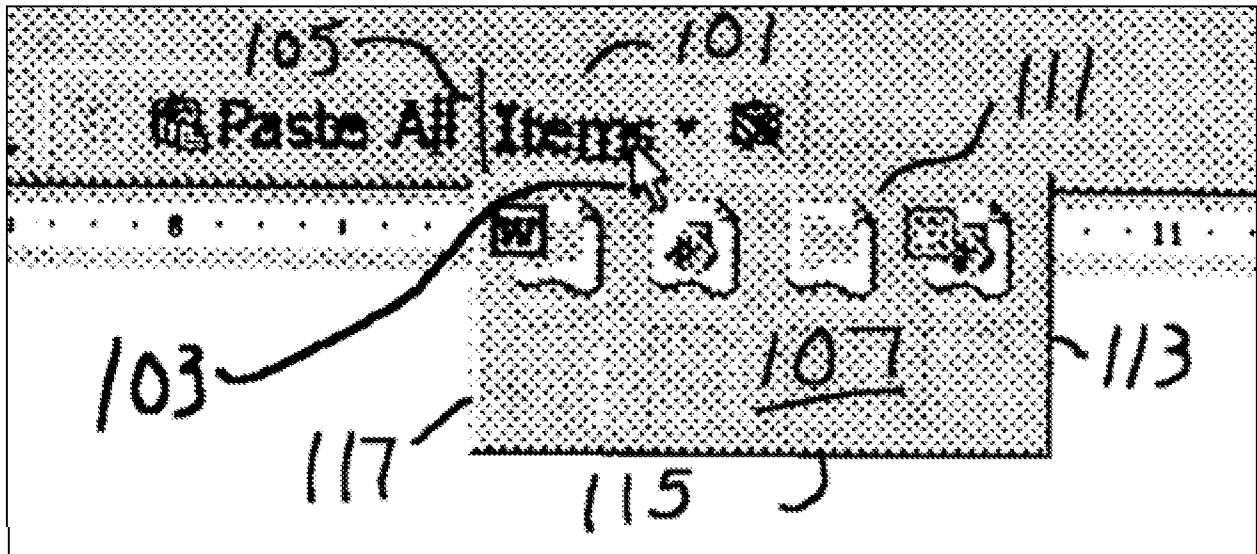


EXHIBIT A

Applicants offer Exhibit A (above), an enlarged and labeled version of Examiner’s Figure 6, to provide more details of the operation of *MSword*. Moving the cursor across every boundary of the clipboard (111, 113, 115, 117) causes no change in the visibility of the clipboard during repeated trials of the Hinote VP laptop by Applicants’ representative. Applicants urge that the Examiner, as he adjusts cursor positions **103** in *MSword*, to consider what the actual trigger is to cause the clipboard **107** to remain visible post-cursor-exit, and what the actual trigger is to cause the clipboard **107** to disappear. The cursor **103** can encounter the ‘Items’ menu boundary **105** either at the top of the vertical boundary **105**, at the bottom, or any point in between. When the cursor **103** penetrates any part of the boundary **105** *MSword* behaves by removing the clipboard **107**. Accordingly, it is apparent that the **cause** of the removal is the event of the cursor **103** leaving the ‘Items’ menu **101**. It is possible that the cursor of *MSword* is adjacent to the clipboard upon this event occurring. However, the co-incidental cursor moving from adjacent to not adjacent vis-à-vis the clipboard at the moment the cursor **103** exits the left boundary **105**, is clearly not a result of non-adjacency vis-à-vis the clipboard **107**, but rather, *MSword* removes the clipboard **107** based on a triggering event that always is the event of the cursor leaving the ‘Items’ menu **101** to an adjacent menu such as ‘Paste All’ or ‘Delete’.

In contrast, claim 17 recites, “removing the clipboard from a display in response to movement of the display position indicator not adjacent to the clipboard.” Applicants contend

that the claim plainly states a cause and effect. The cause is “movement of the display position indicator not adjacent to the clipboard.” The effect is “removing the clipboard from a display”. The synergy between cause and effect is plainly stated. Strangely, the Examiner urges that because *MSWord* shows that moving a cursor left to right over ‘Items’ (incidentally occurring moments before the cursor leaves the ‘Items’ menu) changes clipboard visibility, therefore the claim limitation is shown. Plainly, the causal relationship in claim 17 is not taught in the manner that MSWord functions. Rather, *MSWord* teaches to remove the clipboard **in response to moving a cursor laterally outside an ‘Items’ menu 101**.

I can make the clipboard disappear by first placing the cursor over the ‘Items’ menu (See Fig. 5), and moving the mouse to the left.
Champion Affidavit dated January 14, 2009, page 11.

In short, *MSWord* teaches to remove the clipboard when the cursor moves from Items menu **101** to the menu item “Paste All”. At that time, the cursor was **already not adjacent to the clipboard**. The *MSWord* clipboard, as shown in the *Champion Affidavit*, was not adjacent **before** crossing to “Paste All” as well as **after** crossing to “Paste All”. Consequently, the fact that the cursor is not adjacent during each of these two stages indicates that non-adjacency does not trigger the effect recited in claim 17.

Even if the *MSWord* cursor becomes “not adjacent” at the moment of transitioning left to right out of Items menu, the weight of the evidence points to the cause as being movement left to right. Repeated trials and examples of cursor non-adjacency include at least *Champion Affidavit* Figures D, F, G, H, and I. As can be seen, *MSWord* persists to show the clipboard even with a cursor being not adjacent. This persistence entirely contradicts the plain language of claim 17.

In summary, claim 17 recites a co-action of cause and effect. The cause is “moving the position indicator so that the position indicator is not adjacent to the clipboard”, the effect is “removing the clipboard”. Ignoring this causal relationship is to entirely read out the “in response to” portion of the claim, and is wholly improper.

Accordingly, for at least the reason that *MSWord* fails to teach the claim 17 recited, “removing the clipboard from a display in response to movement of the display position indicator not adjacent to the clipboard”, Applicants urge that claim 17 is allowable over *MSWord*.

III. 35 U.S.C. § 103 Obviousness

The Examiner has rejected claims 1-3, and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over *Foster* et al. (Patent Number 5,404,442, hereinafter “*Foster*”) in view of Microsoft, “Microsoft Word 2000” (hereinafter “*MSword*”).

The examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 in U.S.C. §103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (U.S. 2007) (citing *In re Khan*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Additionally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

Claim 1 which corresponds to claim 9 is recited below:

A method of previewing a graphical image corresponding to an icon in a clipboard, comprising:
receiving an icon preview instruction from a user; and
displaying the **graphical image** associated with the icon in response to the icon preview instruction.

The Applicants urged in the previous response that *Foster* fails to teach claim 1 reciting, “displaying the graphical image associated with the icon in response to the icon preview instruction”. The Examiner responded:

The Applicant argues “How can Foster display an image in response to an icon preview instruction, if the image is already present on the Foster icon?”

In response, the Examiner respectfully submits that when docked a default generic image is displayed to the user, only under user initiation of a drag operation is it converted in to the object it carries (see column 9, lines 44-51 and figure 5c).

Final Office Action dated November 25, 2008, p. 8.

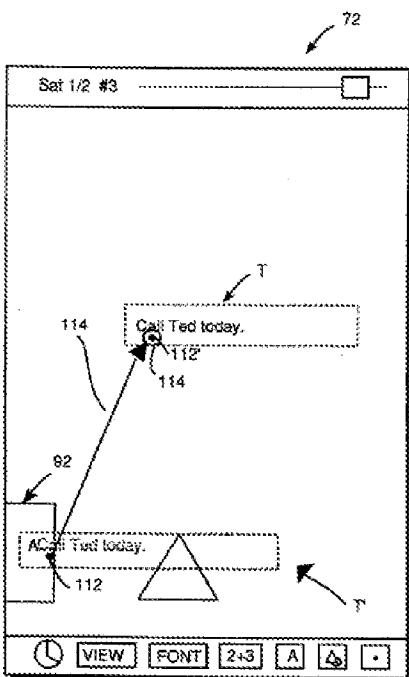


Fig. 5c

In FIG. 5c, visible clipboard icon 92 can be selected by placing a point 112 of stylus 38 near or within its bounding box. In this instance, *the selection of the icon 92 causes a text object T' to appear on the screen* which can be dragged as indicated by the arrow 114. When the point of the stylus 38 reaches the point 112', it can be lifted from the screen as indicated by circle 114 to "paste" the text object T at that location.

Foster col. 9, lines 44-51 (emphasis added).

The Examiner is reminded that the Board of Appeals and Interferences has unequivocally affirmed Applicants by interpreting that a teaching of text does not teach a claim 1 recited, "graphical image".

Nevertheless, we do not find the Examiner's broad reading of the claim to be a reasonable interpretation consistent with how a person of ordinary skill in the art would have interpreted the ordinary and customary meaning of the claim term "graphical image," as opposed to "text."

Board of Patent Appeals and Interferences, Appeal No. 2007-3276, dated January 4, 2008, p. 9.

Appellants have met their burden of showing that the Examiner erred in rejecting claims 1-3 and 9-11 under 35 U.S.C. § 102(a).
Board of Patent Appeals and Interferences, Appeal No. 2007-3276, dated January 4,

2008, p. 12.

Both the passage and asserted Figure 5C show *text*. Accordingly, the Board of Appeals and Interferences agrees with Applicants that a teaching of purely text does not read on the claim 1 recited, “graphical image”. Accordingly, the Examiner has not made a *prima facie* case of obviousness with respect to claim 1. The Examiner admits that *MSword* does not supply this missing limitation of claim 1. Accordingly, by virtue of neither reference teaching this feature of claim 1, claim 1 is allowable over the references for at least this reason.

In addition, one of ordinary skill in the art would not be motivated to combine *MSword* and *Foster* to reach the claimed invention. *MSword* already responds by showing a “the name of the button will appear in a little yellow box” in response to a preview. A user is well aware of the button or paste-buffer’s contents at that point. Moreover, if the user were dragging, in the manner taught by *Foster*, the ‘name’ or other contents with a mouse of *MSword*, **the dragged contents would actually obscure** portions destination document to which the user intends to paste – impairing the user’s ability to position the paste-buffer within or among text. The Examiner suggests a reason to combine:

“that both references analogously transform the representation of the icon upon user initiation of selection to paste (see MS Figure 2 and Foster column 9, lines 44-51 and figure 5c).”

Final office action dated November 25, 2008, p. 8.

Applicants respectfully disagree. Applicants urge that to both show the text when hovering (per *MSword*), as well as when moving the mouse (per *Foster*), are entirely redundant operations, and benefit the user not one wit when performed together. Even if *MSword*’s teaching of displaying the text object were a type of “displaying the graphical image associated with the icon in response to the icon preview instruction”, *MSword* already fills the function of alerting the user as to the nature of the contents of the object before pasting. Accordingly, with such function already satisfied in *MSWord*, there would be no need to have *Foster* also display a hint of the contents while dragging. One of ordinary skill would not combine two references where each redundantly supplies the same function. Moreover, there is a common sense reason to avoid redundant hinting of contents. Namely, the obscuring effect noted above. That is, *Foster*, by dragging the visible contents, now obscures the text of the target document.

Accordingly, the Examiner offers no rational underpinning for an artisan to perform redundant preview operations as would occur when combining *MSWord* with *Foster*. Thus, for this additional reason, the Examiner has failed, with respect to claim 1 and corresponding claim 9, to make a *prima facie* case of obviousness under 35 U.S.C. § 103.

Since claims 2-3 depend from claim 1, the same distinctions between *Foster* and *MSword* references and claim 1 apply to these claims. Additionally, claims 2-3 contain other additional combinations of features not suggested by the reference. For example, claim 2 recites “determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period”. In addition, claim 3 recites “displaying a reduced image of the graphical image”. Consequently, it is respectfully urged that the rejection of claims 2-3 have been overcome.

Since claims 10-11 depend from claim 9, the same distinctions between *Foster* and *MSword* and the claimed invention in claim 9 apply to these claims. Additionally, claims 10-11 claim other additional combinations of features not suggested by the reference. For example, computer usable code for determining whether a display position indicator is positioned over the icon displayed in the clipboard for a predetermined time period (claim 10), or computer readable code for displaying a reduced image of the graphical image (claim 11). Consequently, it is respectfully urged that the rejection of claims 10-11 have been overcome.

IV. Conclusion

It is respectfully urged that the subject application is patentable over *Foster* and *MSword* for at least the reasons stated above, and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: 1/26/2009

Respectfully submitted,

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